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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,417	02/14/2002	Christopher I. Dalton	30006601-2	7557

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EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/075,417	DALTON, CHRISTOPHER I.	
	<b>Examiner</b> Prieto Beatriz	<b>Art Unit</b> 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 February 2002.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 14 February 2002 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All   b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. 103736.5.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/02.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_.

***DETAILED ACTION***

1. This communication is in response to Application No. 10/075,417 filed 02/14/02, claims 1-20 has been examined.
2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received for Application No. 0103736.5, filed on 02/15/01 in Great Britain.
3. Objection to Abstract: this application does not contain an abstract of the disclosure in compliance with 37 FR 1.72(b). In this case, a brief narrative of the disclosure as a whole in a *single paragraph* of 150 words or less commencing on a separate sheet following the claims is required (see MPEP §608.01(b)).
4. Objection to the Claims: claims 2-3 are objected to under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In this case, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements (see MPEP 608.01(n)).
5. Claim 1 is objected for minor typographical noted error, in this case the clause "e-mail a text message" seems most likely to mean, "communicating an email text message". This is the applied interpretation for the purposes of examination. Claim 6 recites the limitation "the data store " in the first line of this claim. There is insufficient antecedent basis for this limitation in the claim.
6. Regarding claim 16, it is noted that claim(s) (see 37 CFR 1.75 and MPEP § 608.01(m)), must commence on a separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim *should be separated by a line indentation*. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP 608.01(i)-(p).

***Claim Rejection under 35 U.S.C. 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In this case, there is not found in the disclosure a description, exemplified or suitable time associated with claimed "predetermined elapsed time". There is no description as to what is "an attempted to issue notification", it is not clear, if this is an issued (or attempted to) notification, an issued (or attempted to) notification not completed, canceled, interrupted, uncompleted, unsuccessful by communication failure or human intervention. The question is, was the notification made or not, if not what constitute an "attempt", and what is a "predetermined elapsed time". Applicant is urged to point out as to where is this claim described in the applicant's disclosure, to lead to a suitable interpretation to the claim.

***Claim Rejection under 35 U.S.C. 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 6-7, 9-16, 18 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,781,901 KUZMA.

Regarding claim 1, Kuzma discloses features of the invention, including a method of communicating e-mail a text message over a network from a user terminal (210) to an intended recipient terminal (211 or 212) at a remote location over a network (101) (col 1/lines 5-22), the method comprising the steps of:

a user terminal (110) communicating an email message (401) to a remote recipient terminal (120, 130) over a network (101) (col 2/lines 24-55 and col 5/lines 25-34), the email message comprising text (col 1/lines 22-23);

the user terminal specifying a “confidential message store” address (302 or 402) of a accessible storage means that is capable of being accessed by the recipient computer via the network (col 5/lines 34-50), said storage means including a server (320 of Fig. 4, col 5/lines 51-65) or the user terminal (210) (col 5/lines 15-24);

the user terminal transmitting a file to said store address to reside therein (col 6/lines 52-59), or a server (col 7/lines 11-16),

the user terminal transmitting a “notification” (301 or 401) over the network to the recipient, said notification incorporating said selected store address (302 or 402) (col 5/lines 41-50, 61-65) and an “instruction” indication to the intended recipient to communicate with said store address (col 6/lines 21-29); and

said recipient terminal accessing said store address to retrieve said text message (col 5/45-50 and col 6/lines 35-40), although Kuzma teaches transmitting storing in a server or storage means accessible by the recipient, he does not teach storing an email message in said store address;

Kuzma suggest that the store address accessible by the recipient, may comprises an address that points to the location of an email (col 13/lines 6-7).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestions of Kuzma for transmitting a notification without accompanying an email, and an store address providing a location at a Web HTTP server or a PC accessible by the recipient computer via the network storing an email or an attachment. One ordinary skilled in the art would be motivated send a notification in the e.g. an HTML form, an email or attachment file, accessible from any computer without requiring modification to existing email software, allowing the stored information to be updateable and including an address of a server running on a personal computer, as suggested by Kuzma.

Regarding claims 2-4 and 6, selecting the message store address from a range of possible addresses (e.g. directory, col 3/lines 24-31); storing at store address before sending notification of store address (col 13/lines 60-col 14/line 9); the user terminal is a personal computer (col 3/line 11-15) and the data store address is an address of a server incorporated into the personal computer (col 4/lines 41-47).

Regarding claims 7 and 10, in which the message store is a server that is connected by or accessible through the Internet network, i.e. “remote” from the user terminal (col 3/lines 16-43)

Regarding claims 9-10, deleting the text message from the message store following accessing of the text message by the recipient terminal and by a predetermined number of recipient terminals (col 6/lines 64-67).

Regarding claims 11 and 20, Kuzma does not explicitly teach allowing access based on a successful authentication.

Official Notice (see MPEP § 2144.03 Reliance on "Well Known" Prior Art) is taken that allowing access to resources by a server to a requesting client upon a successful authentication was old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention given Kuzma's suggestion of ensuring that unauthorized web users do not have access to resources associated with the message store address of a web server. It would have been obvious to one ordinary skilled in the art to implement an client-server based authentication scheme (i.e. validation or verification of users right to access resources), where user is granted access upon a successful (positive or approved) determination that the requesting entity does as rights to requested resources. One would be motivated to apply techniques having related purposes of restricting access to resource, as suggested by Kuzma, such as private resources readily available over public means such as the Internet.

Regarding claim 13, the method claim is substantially the same as claim 1, wherein further the user terminal recited on claim 1 is now a personal computer (Kuzma: col 3/lines 11-15), same rationale of rejection is applicable.

Regarding claim 14, this method claim is substantially the same as claim 1, wherein further the personal computer further comprises a “personal web” server (Kuzma: col 4/lines 41-44), same rationale of rejection is applicable.

Regarding claim 15, this is the computer program product comprising computer readable program code executable by a user terminal to cause the following steps discussed on claim 1, same rationale of rejection is applicable, wherein further the transmission of an email is in response to a user selection “command” (Kuzma: col 3/lines 39-43).

Regarding claim 16, this apparatus claim, i.e. computer terminal configured to perform the functions discussed on claims 1, 13-15, selection or command hereby described as “input instruction” causing an email transmission, same rationale of rejection is applicable.

Claim 17 (discussed above).

Regarding claim 18, this claim is substantially the same as claim 6, same rationale of rejection is applicable.

Claim 20 (discussed above).

***Claim Rejection under 35 U.S.C. 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 19 and 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma in view of U.S. Patent No. 6,618,747 Flynn et. al. (Flynn hereafter).

Regarding claims 19 and 8, Kuzma does not teach informing the access of an address to the user terminal, nor monitoring access to stored message by recipient.

Flynn teaches in the applicant’s field of endeavor, informing “reporting” the access of an address (e.g. address port monitored) by a recipient to the user of the sender terminal (col 2/lines 39-col 3/line 5), as the recipient access store address, the sender is notified of said access by a person at the address of the recipient, the notice “report” includes the time, and date stamp of said access/retrieval (col 3/lines 6-17).

Flynn teaches monitoring the accessing by the recipient terminal of said text message from said message store, by monitoring retrieval operation by recipients to specified address (col 2/lines 42-col 3/line 5).

It would have been obvious to one ordinary skilled in the art at the time the invention was made

given the suggestion of Kuzma for notification to the recipient of the availability of a communication at a store address, the teachings of Flynn for notifying the recipient of the availability of a communication at a store address would be readily available. One would be motivated to further notify the sender when the recipient access and retrieves said communication for providing information as to whether the intended recipient has retrieved a communication current not provided by existing protocol servers, e.g. TCP or SMTP, as noted by Flynn.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma in view of U.S. Patent No. 5,928,325 Shaughnessy et. al. (Shaughnessy).

Regarding claim 5, however Kuzma does not explicit teach an user terminal comprising a mobile telephone.

Shaughnessy teaches the desirability of sending text messages to intended recipients using multiple user devices such as cellular phones and pager (col 5/lines 30-40).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma for implementing his teachings on any suitable computer system in addition to personal computers or a general-purpose microprocessor, the teachings of Shaughnessy for transmitting text messages to a plurality of recipient having different user devices would be readily apparent. One motivation to combine the teachings would be integrate disparate network, expanding Kuzma's system requiring no intelligence on part of the communication network, being software implemented on the server, enabling internetwork interconnection cost effectively, yet maintaining the benefits of having multiple devices associated with distinct and separate networks, as noted by Shaughnessy.

**Pertinent Prior Art:**

13. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure, pertinence is presented in accordance with MPEP§ 707.05. Copies of Non-Patent Literature documents cited will be provided as set forth in MPEP§ 707.05(a):

US 5,560,008 Remote authentication and authorization in a distributed data processing system

Johnson et. al. teaches an server implemented authentication scheme, including validating a resource requesting user identity for a service request, if authentication is successful a reply is sent indicating a successful request for service and requesting user is granted access to resources (Fig. 8)

**US 5,845,070 Security system for internet provider transaction**

Ikudome teaches where an authentication server, reading a successful match will communicate with the POP identifying the assigned framed IP address to the user. There is provided in the certification server validation data that authenticates the Internet Entity as authorized to offer its services on the Internet.

**US 5,276,735 Data enclave and trusted path system**

Boebert teaches an authentication scheme where user identify, e.g. (PIN 50, and User UID 48) is evaluated against an are authentication record belonging to this user 5, i.e. comparing said user identity that was entered against the stored value, and checks the Last Countersign 62' from the Personal Keying Device 30 against the stored value from the previous identification and authentication interaction. Based on these checks the logic computes a Result 94 (e.g., "Login Successful," "Login Failed") and in the case of successful identification, a set of privileges which that user may exercise in future interactions with the Security Server 24.

**US 5,748,084 Device security system**

Isikoff teaches a mobile telephone comprising a laptop computer 100 configured for relaying voice, data, faxes, e-mail, pages, file transfers etc. and may be initiated by either the laptop computer user or a calling party wherein the laptop computer contains a cellular phone transceiver. The transceiver is activated user command, i.e. manually initiated by a user calling out, connecting to another computer or network, and sending or receiving data, or it may include software of a type known in the art to effect automatic file transfer and data backup with a remote host or network, at scheduled intervals. Upon user instruction, e.g. by entering an e-mail and clicking "SEND", transmission is initiated.

**US 5,960,074 Mobile tele-computer network for motion picture, television and TV advertising production**

Clark discloses the incorporation of email, FTP and IRC services, as well as video conferencing in a web-based software application running on a mobile phone.

**US 6,138,096 Apparatus for speech-based generation, audio translation, and manipulation of text messages over voice lines**

Chan et. al. discloses the transmission of an email message over the Internet using a portable unit or conventional telephone/mobile phone

**US 4,987,559 Semiconductor memory device having a plurality of access ports**

Miyauchi et. al. Teaches randomly selecting a store address from a range of sequentially located storage location addresses.

**US 4,546,451 Raster graphics display refresh memory architecture offering rapid access speed**

Bruce teaches storing data at a predetermined storage location by selecting the storage address from a range of possible addresses.

**US 6,490,614 Electronic multimedia message collaboration by automatically recalling electronic message from recipient who has not yet opened electronic message which is performed if proposal is approve**

Shaffer et. al. teaches a method receiving a proposal associated with an issued electronic message (204) for determining whether the proposal is approved (206). The electronic message is automatically recalled from a recipient who has not yet opened the electronic message. The automatic recalling of the electronic message is performed if the proposal is approved (212). Electronic multimedia message collaboration by automatically recalling electronic message from recipient who has not yet opened electronic message which is performed if proposal is approve

**US 5,978,836 Workflow systems and methods**

Ouchi discloses wherein some e-mail systems, such as Microsoft Exchange, have an e-mail recall function that removes unopened e-mail from the e-mail in-box of a recipient. This can recover e-mails sent to a user who is not processing workflow documents and is holding up documents in process.

**US 6,049,796 Personal digital assistant with real time search capability**

Siltoinen discloses the use of a PDS, or cell-phone running an email application for composing/sending or receiving email messages. The user can then send the E-mail immediately or can delay the sending to a later time, in either case using the same contact database 11 to acquire the E-mail address. If the sending is delayed the PDA 10b creates a temporary file to store the E-mail, where it will be later retrieved, when the user desires to send the message.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free)).

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(703) 872-9306, for Official communications and entry;

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